

REMARKS

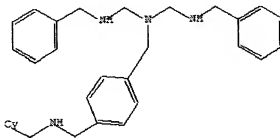
Applicants have amended claims 29, 32, 35, 47, 51, and 55 by removing a number of members assigned to certain variables recited therein to more particularly point out and distinctly claim the subject matter which they regard as their own invention. As a result, these amended claims each recite Markush groups that are only subsets of those recited in the corresponding original claims. Since all of the members of the Markush groups recited in the original claims must have been examined for the reasons set forth below, the amendments should be entered as they raise no new issues that will require additional consideration or search and also do not touch the merits of the application within the meaning of 37 C.F.R. 1.116(b).

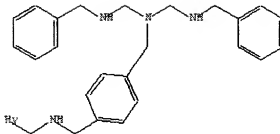
The above amendments have necessitated cancellation of claims 30, 31, 33, 34, 36-46, 48-50, 52-54, 56, and 57 and changes of dependency in claim 32 and 51.

Upon entry of the above amendment, claims 29, 32, 35, 47, 51, and 55 will be pending and under examination. Reconsideration of this application is requested in view of the following remarks.

Objection

The Examiner objects to independent claims 29, 40, and 47, asserting that they contain non-elected subject matter. He sets forth two core structures based on compound 25 (the single species elected by Applicants) and requires that Applicants limit claims 29, 40, and 47 to the compounds containing either of them. See the final Office Action, page 2, line 13 through page 3, line 6. The two core structures are reproduced below:





Claim 40 has been cancelled. Claims 29 and 47, both of which are Markush-type claims, will be discussed below.

Applicants believe that the Examiner's requirement is inconsistent with the Office's examination guideline. The MPEP guideline regarding the examination of a Markush-type claim reads in relevant part:

"should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected species*, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The examination will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action can be made final..." (MPEP 803.02; emphasis added)

It is clear that if the elected species is allowable, the Examiner should consider a Markush-type claim to its full extent unless prior art is found to anticipate or render obvious a nonelected species covered by the claim.

In this case, the Examiner has determined that the elected species, i.e., compound 25, is allowable. Specifically, he states in the final Office Action that "[c]ompounds [including compound 25] having the above cores were not found to be

taught or suggested in the art.” See page 3, lines 6-7. On the other hand, the Examiner relied on U.S. Patent Nos. 5,567,411 and 5,252,317 to reject claims 29 and 47 for obviousness in the first Office Action dated June 4, 2007. He clearly believed that these two references render obvious the Markush-type claims with respect to a *nonelected species*, as he admits that the elected species is “not taught or suggested in the art.” In any event, the Examiner withdrew this rejection in view of Applicants’ arguments presented in the response dated September 4, 2007. In other words, the two cited references do not constitute prior art against original claims 29 and 47.

In sum, the Examiner has not found any prior art that anticipates or renders obvious original claims 29 and 47. Following the above-quoted MPEP guideline, the Examiner should have examined Markush-type claims 29 and 47 “to the extent necessary to determine [their] patentability.” He clearly errs in requiring Applicants to limit these claims to compounds having one of the two above-shown core structures. Applicants therefore request that the Examiner withdraw the objection.

To facilitate the examination, Applicants have significantly narrowed claims 29 and 47. The compounds called for in the thus-amended claims all share a unique structural feature. More specifically, these compounds all have three chains bonded to a central nitrogen atom, two being alkylene-NH-alkylene-(aryl or heteroaryl) chains and one being an alkylene-(cyclic ring)-alkylene-NH-alkylene-(cyclic ring) chain. Search for and examination of claims 29 and 47 can be conducted based on the afore-mentioned unique structural feature without undue burden. Applicants therefore respectfully request that the Examiner consider claims 29 and 47, as amended.

Applicants would also like to point out errors in the two core structures shown in the final Office Action (also shown above). Each core structure contains two CH₂ moieties between three nitrogen atoms. By contrast, elected compound 25 contains two (CH₂CH₂) moieties between three nitrogen atoms. As the core structures were set forth based on the elected compound, the Examiner clearly misrepresented the CH₂ moieties for the CH₂CH₂ moieties in the core structures. Appropriate correction is therefore requested.

Elected subject matter

The Examiner asserts that claims 30-39, 41-46, and 48-57 are withdrawn from consideration, as they are directed non-elected subject matter.

Applicants disagree. Claims 30, 31, 33, 34, 36-46, 48-50, 52-54, 56, and 57 have been cancelled. Applicants will only discuss claims 32, 35, 51, and 55 below.

As pointed out in the last response, according to the restriction requirement, original claim 32, 35, 51, and 55 belong to Group III elected by Applicants. Further, each of these claims reads on elected compound 25. Thus, the Examiner clearly errs in asserting that all of these claims are directed to non-elected subject matter.

Applicants have narrowed claims 32, 35, 51, and 55. The narrowed claims are therefore subsets of subject matter covered by elected Group III. Further, these claims, narrower in scope than the original claims, still cover elected compound 25. In short, like original claims 32, 35, 51, and 55, these narrowed claims are directed to elected subject matter. It is respectfully requested that the Examiner consider these claims on their merits together with claims 20 and 47.

Request for withdrawal of finality

As pointed out above, the Examiner errs in failing to examiner Markush-type claims 29 and 47 to their full extents and failing to consider claims 32, 35, 51, and 55. Applicants therefore request that the Examiner withdraw the finality of this office action and reconsider claims 29, 32, 35, 47, 51, and 55, as amended.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any

claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Petition for Extension of Time fee in the amount of \$60 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 60001-003001.

Respectfully submitted,

Date: 4-17-08

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